IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: **Kevin Calloway**

Serial Number: 09/708,235 - 2009-0171   Examiner: ALVEREZ, Raquel

Filed: 11/7/2000   Art Unit: 3688

For: MULTIMEDIA MESSAGING METHOD AND SYSTEM

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REVISED APPEAL BRIEF UNDER 37 CFR 1.192

Dear Sir or Madam:

REAL PARTY IN INTEREST

The real party in interest is Alterian, LLC

RELATED APPEALS AND INTERFERENCES

Applicant appealed previously and the Board of Patent Appeals and Interferences

ruled in Applicant's favor. Appeal no. 2009-0171, Decision of May 1, 2009. A copy of

the Decision of the Board is attached hereto as an Appendix.

STATUS OF CLAIMS

Claims 1-63 and 71-78 are pending and rejected, and the appeal is on the rejection

of these claims. Claims 64-70 have been cancelled.

STATUS OF AMENDMENTS

No amendments were filed after final rejection.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, in one embodiment, is a method and device for creating multiple individualized multimedia messages over a computer network to multiple recipients, respectively, all at one time. (p. 18 lines 3-11) Claims 1, 3, 20 and 55 are set forth below with reference and thus mapping to specific, exemplary portions of the application's drawing figures and application's text.

Individualization or personalization occurs from at least two sources, i.e., data in a recipients' database (e.g., recipient's name and address) and certain preset rules ("business logic rules"), e.g., providing local hotels or restaurants based on the address information for the individual. This is a second level of personalization which is above a first level, i.e., mere use of the recipient's data in the message (such as recipient's name in a greeting).

Multimedia messages incorporate different media, e.g., text and/or graphics, along with video and/or audio. (p. 24 line 21– p. 25 line 2)

The messages are preferably "filled" at the time of viewing or opening by the recipient, e.g., the message contains a URL or other link to a database such that when the message is opened, the data from the database is sent to the message (P. 25 lines 9- 22). This aspect of the invention enables extremely fast sending of large groups of messages, in spite of individualization and in spite of multimedia content which may contain

relatively large files. For example, messages can be sent simultaneously to at least 500 or

more recipients with different multimedia content. (p.30, line 9). The method and device

even allow a message to be updated by updating the data with which the message will be

filled when opened or viewed. In other words, the message contains a link or links back

to the sender's database (or elsewhere) to the specific individualized information.

In another aspect of the invention, there is a unique URL assigned to each e-mail,

and this URL carries information about the user. (Page 8, line 20 to Page 9, line 4 and

Fig. 14 plus Page 54, line 10 to Page 56, line 19). Therefore, the speed with which a

message can be individualized is enhanced because there is no need to store prior

information about messages sent to the user. The unique URL does that, and when it is

updated, it carries new information about the user.

The combination of assigning the unique URL with each email, and the filling of

the email upon viewing or opening is synergistic, enabling a large number of emails to be

sent simultaneously, yet have unique information for different recipients. (Page 8, line 20

to Page 9 line 4 and also Page 11, lines 1-8). Not only does the system work for 500

emails with unique multimedia content, but vast numbers such as 400,000, 500,000 or

1,000,000. (See illustrative examples of hypothetical campaigns which the system is

capable of conducting, located at pages 27 (line 8), 28 (line 3), 29 (line 14) and 30 (line

9)).

A description of each of the independent claims discussed herein with reference to

the element numbering and drawings, with specification page and line number references

is set forth below.

CLAIM 1

Claim 1 recites a system (e.g., messaging system 10 with recipient and media repositories 12, 14 and Figs. 1-4 and 9) for creating and distributing a series of individualized multimedia messages (p. 25, lines 9-10) over a computer network (16) using an email message (e.g., p. 18 lines 3-11 and Figs. 1 to 3 and 9) sent simultaneously (e.g., p. 18, line 9) to at least five hundred recipients (e.g., p. 30, line 9). The system has the following elements:

(a) a recipient information repository (12) (e.g., Figs. 1 to 3 and 9, electronic storage media 12, p. 17, lines 17-19) with unique recipient information (e.g., p. 25, lines 9-10) for at least five hundred recipients (e.g., p. 30, line 9);

(b) a multimedia content repository (14) (e.g., Figs. 1 to 3 and 9, electronic storage media 14, p. 17, lines 18-19) with computer files having at least one of text and graphics files, and at least one of audio and video files (e.g., p. 24, line 21– p. 25 line 2); and

(c) the multimedia engine (30) and delivery system (32) create and deliver individualized multimedia content (e.g., p. 4, lines 8-9) over the computer network, which sends email simultaneously (e.g., p. 18, line 9) to each of the at least five hundred recipients (see, e.g., Figs. 4 and 9, e.g. multimedia engine 30 and delivery 32 and e.g., p. 30, line 9), and the multimedia content is assembled from selected elements within the multimedia content repository (14) which are selected in response to individual information (e.g., p. 4, lines 8-9) about each of the recipients whose individual information is extracted from the recipient information repository (12) and at least some of the

individualized multimedia content for the recipients are different from other of

the content (see, e.g., Figs. 4 and 9, e.g. multimedia engine 30 and delivery 32

and e.g., p. 30, line 9 and p. 4 lines 3-8—"individualizing content").

CLAIM 3

Claim 3 recites a system (e.g., messaging system 10 with recipient and media

repositories 12, 14 and Figs. 1-4 and 9) for creating and delivering a series of

individualized multimedia messages (p. 25, lines 9-10) over a computer network (16)

using an email message (e.g., p. 18 lines 3-11 and Figs. 1 to 3 and 9) sent simultaneously

(e.g., p. 18, line 9). The system has the following elements:

a content management system (28) for accessing information about an intended

recipient with unique recipient information (from electronic storage media 12) for each of

at least five hundred recipients (e.g., Figs. 1 to 3 and 9, , p. 17, lines 17-19, p. 25, lines 9-

10, p. 30, line 9);

a multimedia engine (30) for personalizing a multimedia message with computer

files from electronic storage media (14) having at least one of text and graphics files and

at least one of audio and video files for the intended recipient based upon information

about a particular intended recipient (e.g., Figs. 1 to 3 and 9, p. 17, lines 18-19, p. 24, line

21– p. 25 line 2, p. 25, lines 9-10); and

a delivery system (32) for delivering the multimedia message over the computer

network to an intended recipient (e.g., p. 4, lines 8-9, Figs. 4 and 9, and e.g., p. 30, line 9a

and p. 4 lines 3-8—"individualizing content") including sending an email message

simultaneously to each of at least five hundred recipients (e.g., p. 18 lines 3-11 and Figs.

1 to 3 and 9, p. 30, line 9), and at least some of the individualized multimedia content for the five hundred recipients are different from at least some other of the multimedia content (e.g., p. 4, lines 8-9, Figs. 4 and 9, and e.g., p. 30, line 9 and p. 4 lines 3-8— "individualizing content").

CLAIM 20

Claim 20 recites a system (e.g., messaging system 10 with recipient and media repositories 12, 14 and Figs. 1-4 and 9) for creating and distributing at least five hundred individualized multimedia messages (e.g., p. 30, line 9 and p. 25, lines 9-10) over a computer network (16) using an email sent simultaneously (e.g., p. 18, line 9). The system has the following:

(a) a computer (e.g., Fig. 9, at client 18 and e.g., with system 10) operatively connected to the network and executing a programmed sequence of instructions;

(b) a recipient information access routine (e.g., XML interface 40, Fig. 4, p. 24, lines 14-16) within the instructions for accessing data about a given intended recipient with unique recipient information (from repository 12) for each of at least five hundred recipients (e.g., p. 30, line 9 and p. 25, lines 9-10);

(c) a content repository (14) containing multimedia elements that may be combined to form individualized messages with computer files having at least one of text and graphics files, and at least one of audio and video files;

(d) a content management routine within the instructions for retrieving selected multimedia content from the content repository (e.g., content management subsystem 28 and client interface 42, Fig. 4, p. 24, lines 15-21 and p. 25, lines 1-3), the

process of selecting multimedia content is responsive to information content regarding

the given recipient accessed by the recipient information access routine (e.g., Fig. 4, and

p. 25, lines 9-17);

(e)   a multimedia engine routine within said programmed sequence of

instructions, for packaging the multimedia content as an individualized message for

delivery to the given recipient (e.g., multimedia engine 30, Fig. 4, p. 25, lines 14-16) ;

and

(f)   a delivery routine within the instructions for delivering the individualized

message to each of the recipients including sending an email message (e.g., Fig. 4, and

delivery system 32 and email delivery subsystem 54, p. 16-20, et seq) simultaneously to

each of at least five hundred recipients and some of the individualized multimedia

content for the five hundred recipients are different from other of the content (e.g., p. 4,

lines 8-9, Figs. 4 and 9, and e.g., p. 30, line 9a and p. 4 lines 3-8—"individualizing

content").

CLAIM 55

Claim 55 recites a method of creating and distributing individualized multimedia

messages (p. 25, lines 9-10) over a computer network (16) using an email message sent

simultaneously to at least five hundred recipients (e.g., p. 18 lines 3-11 and Figs. 1 to 3

and 9, p. 30, line 9).   The method includes the following steps:

retrieving information about an intended message recipient from a recipient

database using a computer (e.g., step 70, Fig.7, p.32, lines 4-5, or step 60, Fig. 6);

personalizing a multimedia message for each recipient based on the retrieved information with the unique recipient information for at least five hundred recipients and the multimedia message including computer files comprising at least one of text and graphics files, and at least one of audio and video files (e.g., step 72, Fig. 7, p.32, line 5, as well as e.g., p. 4, lines 8-9, Figs. 4 and 9, and e.g., p. 30, line 9a and p. 4 lines 3-8—"individualizing content", or step 62, Fig. 6); and

delivering, by using an email sent simultaneously to each of the at least five hundred recipients, the multimedia message to each of said recipients over a computer network and at least some of the individualized multimedia content for the at least five hundred recipients are different from at least some other content files (e.g., step 74, Fig. 7, p.32, lines 6-10 or step 64, Fig. 6, as well as e.g., p. 4, lines 8-9, Figs. 4 and 9, and e.g., p. 30, line 9a and p. 4 lines 3-8—"individualizing content, p. 18 lines 3-11 and Figs. 1 to 3 and 9, p. 30, line 9, and e.g., p. 30, line 9 and p. 4 lines 3-8—"individualizing content").

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. In the Office Action of February 26, 2010 (p. 2) Claims 1-15, 18-33, 36-63 and

71-78 were rejected under 35 USC 103(a) as being unpatentable over Hibbeler USP

6,076,348 (previously cited in view of Official Notice) now in view of Beyda USP

6,636,965. Is this rejection proper? For claims 1-15, 18-33, 55, 57, 58, 71-72, and 74,

would it have been obvious to one of ordinary skill in the art to have included messages

being graphic or video in view of Beyda's Fig. 2 with Hibbeler, a system for creating and

distributing individualized multimedia messages?

2. In the Office Action (p. 8) claims16-17, 34-35 and 75-78 were rejected under

35 USC 103(a) as being unpatentable over Hibbeler in view of Beyda et al, further in

view of Smith et al (U.S. Patent No. 6,725,381) Is this rejection proper? For these

claims, would it have been obvious to one of ordinary skill in the art to include a unique

URL?

ARGUMENT

A. CLAIMS 1-15, 18-33, 36-63 and 71-74,:

Claims 1-15, 18-33, 36-63 and 71-74 have been rejected as being unpatentable over Hibbeler (U.S. Patent No. 6,067,348) in view of Beyda (U.S. Patent No. 6,636,965). It is asserted that Hibbeler teaches creation of a series of individualized messages over a computer network for a plurality of recipients. It is further asserted in the Action that Beyda teaches an email system for sending multimedia to the recipient's email (Fig. 2) and that these emails can contain unique information ("customized encrypted multimedia message" and that the email server is "<u>capable</u> of sending message [sic] to a plurality of recipients simultaneously." Column 3, line 8-32 are cited. However, it would not have been obvious to combine Hibbler with Beyda, and even if it were, it would not result in the claimed invention.

Hibbeler is an audio (voice mail) medium while Beyda is an email system. It would not have been obvious to one of ordinary skill in the art to create a system for creating and distributing individualized multimedia messages at the time of the invention.

1. Claim 1:

In one embodiment, the claimed invention is <u>more</u> than simply personalizing an email by inserting a name in the text. The email template which is applicable to the recipient is generated from lookup in a database using unique recipient data, unique data in multimedia, and synchronization of the multimedia data.

Claim 1 recites a message creation and distribution system where:

i.   the recipient information repository contains unique information about multiple recipients,

ii.   the multimedia content repository is defined so that it contains (a) at least one of text and graphics files, and (b) at least one of audio and video files;

iii.   the messages are sent to at least 500 people simultaneously; and

iv.   the messages are provided with unique (individualized) content.

The defined multimedia content i.e., (a) the text and/or graphics files along with (b) the audio and/or video files, are selected based on the recipient information and delivered over the computer network.

This combination of elements (i) and (ii) including (a) and (b) as well as (iii) and (iv) above is not shown or suggested by Hibbeler alone or in combination with Beyda. In the first appeal, the Board found that Hibbeler lacked multimedia as defined in the claims. (See Appealed Decision). After the Board's May 1, 2004 decision, the Examiner conducted a further search and cited a patent to Faynberg (U.S. Patent No. 6,067,348) to combine with Hibbeler. Applicant responded with Amendments and Arguments, and then the rejection was withdrawn. In the next office action, a new reference, Beyda, was cited. Applicant takes this appeal.

Hibbeler teaches a phone message (outbound message) personalization by inserting a recipient's first name from "name storage 100" into a message.

1.   In Hibbeler, the message is merely audio, and thus is not "multimedia," as defined by the claim

2.   In Hibbeler, the message body does not vary from recipient to recipient. An audio of the recipient's first name is a "greeting segment" and is simply placed before the message body.

3.   In Hibbeler, there is no selection of message content based on (but different from just) the individual recipient information.

4.   In Hibbeler, **the message is sent and is not changed when sent, whether digital or not. Absolutely no method is disclosed or suggested for changing a message after broadcasting the message.**

Hibbeler merely adds a name before or in an otherwise fixed message. There is no teaching of multimedia computer files and there is no teaching of changing the multimedia content based on the personalized data, rather than simply adding personal (unchanged) data to the message.
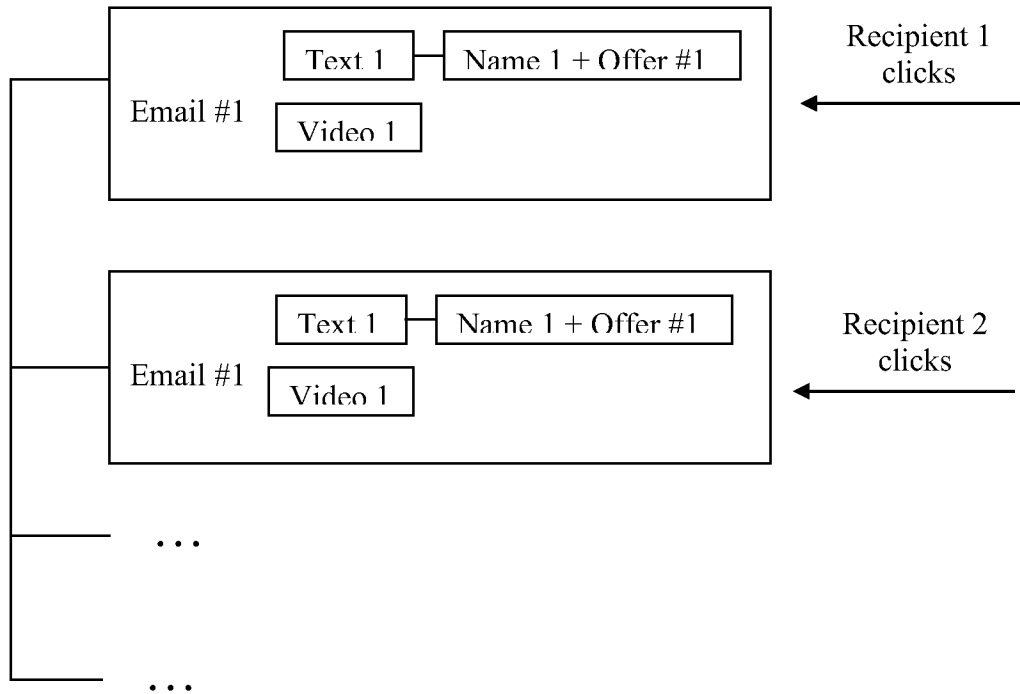
Hibbeler's use of digital formatting for sending or storing the message **is not multimedia format,** and certainly is not multimedia format as set forth in claim 1, which defines multimedia content as containing at least one of element (ii)(a) AND at least one of element (ii)(b) (as set forth above). The end result is simply a voice message. Moreover, multimedia is defined in the claims, e.g., in claim 1 and further defined in claim 3, in a way not shown or suggested by Hibbeler. Further, there is NO way to produce multimedia in a voice message. Moreover, no art is cited to show multimedia as defined as well as content personalization of the multimedia content (rather than a simple pass through of the stored recipient data (such as the name pass through in Hibbeler).

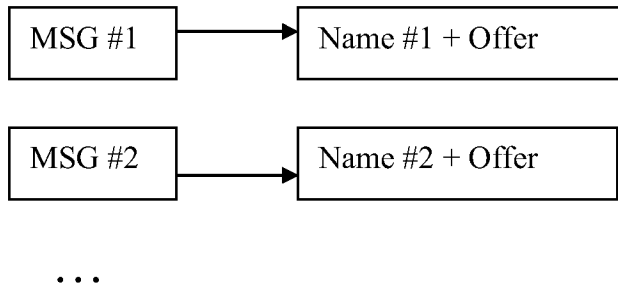The table below and diagrams below emphasize the above points.

Claim 1	Hibbeler
A system for creating and distributing a series of individualized multimedia messages over a computer network to a plurality of recipients, comprising:	Creates multiple voice mail messages which can be delivered electronically

(a) a recipient information repository with unique recipient information for at least a first and second recipient;	Personal <u>names</u> may be inserted into a message from name storage 100
(b) a multimedia content repository with computer files comprising at least one of text and graphics files, and further comprising at least one of audio and video files; and	Voice only – no multimedia and no way to deliver multimedia (Note that claim element (b) defines "multimedia")
(c) means for creating and delivering individualized multimedia content over said computer network to each of the plurality of recipients, wherein said multimedia content is assembled from selected elements within the multimedia content repository which are selected in response to individual information about each of said recipients whose individual information is extracted from the recipient information repository.	No way to create and/or deliver multimedia content; no selection of multimedia content based on individualized information

CHANGEABLE CONTENT BEFORE RECIPIENT CLICKS

Email #1

Text 1 — Name 1 + Offer #1

Video 1

Recipient 1
clicks

Email #1

Text 1 — Name 1 + Offer #1

Video 1

Recipient 2
clicks

. . .

. . .

HIBBELER

MSG #1 → Name #1 + Offer

MSG #2 → Name #2 + Offer

. . .

Beyda teaches an email system for embedding recipient specific comments into an email. Beyda uses encryption to do so. As shown in Fig. 2, the general process is as follows:

Generate common message for all recipients (step 50)

Select recipients for the common message (step 52)

Generate one or more encrypted comments to the common message (step 54)

Select recipients for encrypted comments (step 56)

Deliver message included encrypted comments to message processor (step 58)

However, Beyda does not simultaneously send unique messages to all recipients. Rather, Beyda has two alternative mehthods. In the method of Fig. 4, Beyda includes a link in the email that is the same for all recipients. Instead of sending unique information to the recipient, the recipient must, after opening the email, click on the link. If the recipient then enters a proper password, the recipient then has access to the comments. See, Fig. 4 of Beyda. The comments are encrypted for all recipients and sent to all recipients, but somehow only the intended recipients of the comments can actually read the comments. (Col. 3, lines 18-26)

In the method of Fig. 3 of Beyda, the processing shown is carried out before the messages are sent out. (Col. 3, lines 37-43) Basically, there is an address list for the entire email distribution, and a sublist containing the email addresses for which the comments are intended. In this method, the system must make a one-by-one determination as to whether the email recipient is on the sub-list or not. If not, the system

only sends the common portion and if on the sub-list, the system sends out the common portion plus the comments.

In such a system, unique emails are not simultaneously sent out. Customized messages are assembled in advance, but segmented into one type of message or another.

Combining the voice mail system of Hibbeler with the email system of Beyda would not have been obvious to one of ordinary skill in the art, and in any event would not result in the claimed invention. Hibbeler relates to voice mail. Beyda relates to email and specifically a way of getting unique comments to email recipients. Beyda does not send one message to all at the same time. Rather, Beyda sends first messages to one list and another message (the first message plus comments) to another list. Hibbeler concerns sending messages with some changes in the recipient greeting (e.g., Hello _____, where one message is "Hello John" and another might be "Hello Sally"). The two systems have nothing in common.

Even if Hibbeler would somehow be modified in view of Beyda or vice versa, the resultant system would not be the claimed invention. The claimed invention sends many emails simultaneously, which emails will be filled with unique information. In the application, the way this is done is by sending emails simultaneously which are essentially empty at the time of sending, and associated with a unique URL, and when the recipient opens the email, it is filled by the system based on the unique URL. That way, there is unique multimedia content assembled "on the fly" (after the message is sent and delivered upon opening the message). (As discussed below, the dependent claims 16, 17, 34-38, 60-62 emphasize the unique URL of the invention, or both, and the dependent

claims 57, 60, 71-75 emphasize the filling of the email upon opening the email, and 76-78)

Moreover, Beyda does not teach unique multimedia content. The system of Beyda "allows a user to attach comments to a message for general distribution, wherein the comments are to be received by fewer than all recipients of the common message." (Col. 2, lines 24-38) The multimedia are not different. The comments are what is different from the other emails.

In summary, Hibbeler and Beyda are very different and cannot be combined. Even if they were combinable, the result would lack simultaneously sending out email to many (at least 500) recipients, with means for filling the email with unique multimedia content.

2. Claim 3:

Independent claim 3 has some similarity to claim 1 and is therefore believed patentable in view of claim 1 being patentable.

3. Claim 16:

Claim 16 specifically recites that the message is formatted to contain a unique URL link which retrieves the multimedia message content. According to this aspect of the invention, the content that fills the message need not be sent at the time the message is sent <u>and fills the message later</u>. This aspect of the invention allows many emails to be sent at the same time extremely quickly. In addition, this aspect of the invention **enables**
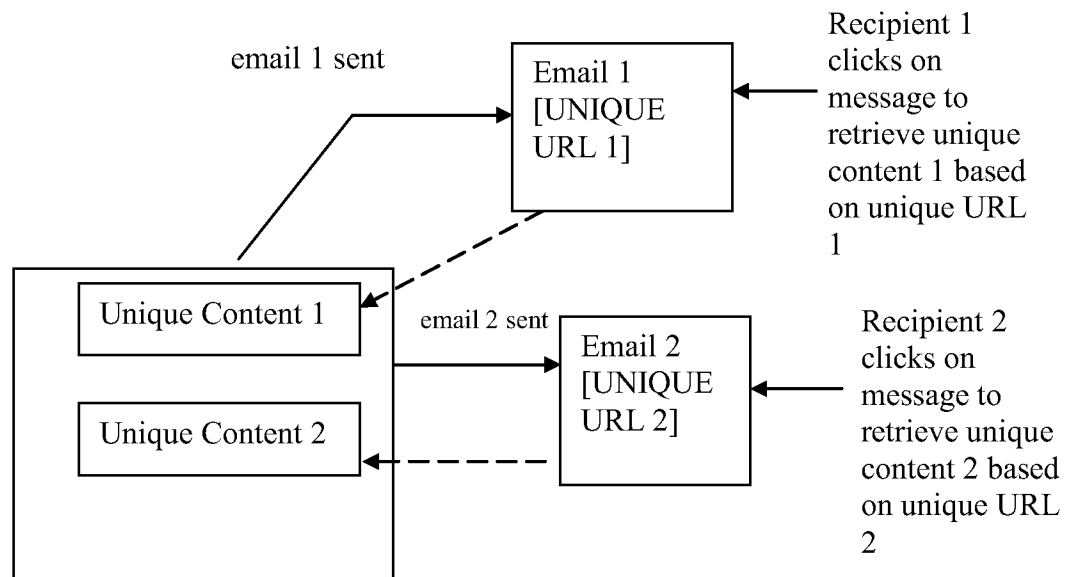
the content of the multimedia message to be changed even after the message has been sent. There is absolutely no suggestion of this feature in Hibbeler or Beyda. Mere capability of changing a message does not support an obviousness rejection.

No art is cited to show the claimed elements. The table and diagram below show creation of unique content from the unique URL, and this "backfilling" of message content after sending the email message. Smith is cited as teaching a unique URL sent with an email. However, it would not have been obvious to combine Smith with Hibbeler and Beyda for the reasons set forth above with respect to Hibbeler and Beyda not being combinable, and not being combinable to achieve the claimed invention. Moreover, Smith does not teach the unique URL as claimed in the invention.

Smith teaches a system for "solicited authentication of a specific user." At the portion (col 4, lines 35-43) cited in the office action, has a URL in the email which the user must click on to retrieve a document. This is not a URL that is used by a processor, in response to the recipient opening an email, to pull certain unique multimedia information and fill the email with it. In the claimed invention, the unique URL allows the mass emailing campaign, and filling the email body with unique multimedia content upon recipient opening the email. That is not the same as a typical link sent in an email. Moreover, the purpose of Smith is to avoid sending the document with the email in case the email gets misdirected, or the party opening the email is not the intended recipient. This does not combine with Beyda's teachings to achieve the claimed invention. Possibly Smith is an alternative to Beyda's Fig. 4 which is a way to send comments encrypted, and requiring the user to enter a password to obtain the comments (or if modified by Smith, obtain a document).

The present invention as claimed is not concerned with achieving security of the delivered message. Rather, the URL is used to fill messages with multimedia content, which content is different/unique for various recipients, yet all of the emails can be sent simultaneously in a large number. Smith's URL has nothing to do with such a system. This applies to claims 75-78 too.

CLAIM 16	HIBBELER
16. A system as recited in claim 11, wherein the individualized multimedia message is formatted for delivery to the recipient as an email message containing a unique URL link that when activated ret	Hibbeler sends the voice mail messages out in a batch process to each recipient.

4. Claim 17:

With respect to claim 17, it recites a first routine to collect individualized data and a second routine to display the data and depends on 16. Therefore, it

emphasizes filling the message after the message has been sent, e.g., upon opening

by the recipient or selection of the link by the recipient. No art is cited to show or

suggest the claimed elements.

5. Claim 20:

Claim 20 is patentably distinct from Hibbeler and Beyda for those reasons set

forth in claim 1. In addition, claim 20 is patentably distinct from Hibbeler and Beyda in

that the multimedia content is selected using recipient data thus providing, as noted

above, a second level of personalization. In other words, the selected multimedia content

that ends up in the message is **of a different type from just the recipient data**. One

example is where the multimedia content is a coupon for a restaurant located in the same

geographic area such as the same city, or same zip code, or within a predetermined radius

of the recipient's location. Another type of data might be the location of a restaurant

(nearest the recipient) of a national chain of restaurants. **This is a step well beyond**

taking a name of a recipient and simply putting it into a message as is done in

Hibbeler or attaching comments or encrypted comments as in Beyda. No art is cited

to show or suggest the claimed elements.

6. Claim 34:

Dependent claim 34 depends on claim 20. It further recites that the delivered

message is an email with recipient's name and email address. **In addition, the email has**

a unique URL pointing to the message content. Accordingly, as noted above with

respect to claim 20, the message may be filled at the time of the recipient clicking on

it, rather than being sent out in field form. This enables rapid sending of many

messages at the same time because the files being sent initially are small. In addition, it

allows the point in time the recipient looks at the message content to be substantially later than the point in time where the message is sent, and allows for data to be updated **even after the message has been sent**. In fact, even after the recipient looks at the message, if the recipient closes it and looks at it again, data could be updated between the first review and the second review of the message. No art is cited to show or suggest the claimed elements.

Neither Hibbeler nor Beyda have any such thing and the cited combination with Smith still does not achieve the claimed invention. (see Section 3 re claim 16 and the unique URL discussion above).

7. Claim 35:

Claim 35 depends on claim 34 and adds the fact that the multimedia content will play when the recipients email inbox is highlighted in addition to the unique URL playing to the message content. This occurs simultaneously and spontaneously. Neither Hibbeler nor Beyda suggest any such thing and it would not have been obvious to one of ordinary skill in the art to do so with or without Smith as explained above. No art is cited to show or suggest the claimed elements.

8. Claim 39:

Claim 39 depends on claim 20 and recites that the client interface management routine contains a graphical user interface for displaying information and allowing direct client input. In this way, the client can dynamically use and change the message content which it sees. Hibbeler teaches no such thing and neither does Beyda. Again, it is respectfully submitted that such would have been obvious. Only through the use of hindsight would it occur to one of ordinary skill in the art. No art is cited to show or

suggest the claimed elements.

9. Claim 40:

Claim 40 depends on claim 20 and recites that the content management routine further includes routines for directing content uploading and customization of the content database. This emphasizes the novelty and nonobviousness of the claimed invention filling messages after sending and filling messages with content that is unique to a user and selected based on recipient data, not just recipient data passed along. No art is cited to show or suggest the claimed elements. See also, discussion of section 1 above.

10. Claim 47:

Dependant claim 47 depends on claim 20 and further recites a reporting routine for real-time reporting of content and usage statistics. This entails **feedback** from the recipient whether or not the recipient intends to provide feedback. Hibbeler provides no such feedback and the concept of feedback in general does not render this aspect of the invention obvious. No art is cited to show or suggest the claimed elements.

11. Claim 48:

Claim 48 is patentably distinct over the art of record in that it depends on claim 47. In addition, it emphasizes feedback by reciting specific forms of feedback, none of which would have been disclosed by or would have been obvious from Hibbeler ir Beyda or the use of feedback in general. No art is cited to show or suggest the claimed elements.

12. Claim 51:

Claim 51 relates to a multimedia engine routine which modifies the message content and specifically recites use of offers, discounts, coupons or rebates after the campaign has been deployed. This specific aspect and advantage of the invention is in no

way disclosed or obvious from Hibbeler or Beyda. No art is cited to show or suggest the claimed elements.

13. Claim 55:

Claim 55 is a method and is patentably distinct from the art of record for substantially the same reasons as claim 1. No art is cited to show or suggest the claimed elements.

14. Claims 60-62:

These recite the unique URL and filling of the email with the unique multimedia content after the email is sent. Therefore, they were believed patentable for the reasons set forth above for claims 16 and 34.

15. Claims 71-74:

In addition, claims 71 to 74 emphasize that the multimedia content repository further includes at least one audio and video file. Use of text and/or graphics having personalized information in combination with audio and/or video having personalized information is in no way possible or disclosed by Hibbeler. No art is cited to show or suggest the claimed elements.

16. Claims 75-78

Claims 75-78. Each emphasizes the unique URL, which carries information about the user, and therefore adds to the speed with which a message can be individualized. There is no need to store prior information about messages sent to the user. The unique URL does that (carries in itself a unique code to fill the message content) and when it is updated, it carries new information about the user. Hibbeler has absolutely no suggestion or disclosure of such a unique URL. No art is cited to show or

suggest the claimed elements. As noted above, Beyda lacks this aspect of the invention.

Beyda assembles email content before sending (Fig. 3 and discussion thereof or has no

unique content as in the Fig. 4 process). Beyda has no unique URL. (See also section 3

above) and as discussed above, e.g. in Section 3 above, Smith does not teach this type of

URL in combination with the other aspects of the invention. (see Section 3 above).

Respectfully submitted,

LAW OFFICES OF DAVID L. HOFFMAN

Date: July ___, 2010   /David L. Hoffman/
                                          David L. Hoffman
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Encls.
Appendices

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APPENDIX

1.   A system for creating and distributing a series of individualized multimedia messages over a computer network using an email message sent simultaneously to at least five hundred recipients, comprising:

(d) a recipient information repository with unique recipient information for at least five hundred recipients;

(e) a multimedia content repository with computer files comprising at least one of text and graphics files, and further comprising at least one of audio and video files; and

(f) means for creating and delivering individualized multimedia content over said computer network including sending an email simultaneously to each of at least five hundred recipients, wherein said multimedia content is assembled from selected elements within the multimedia content repository which are selected in response to individual information about each of said recipients whose individual information is extracted from the recipient information repository and wherein at least some of said individualized multimedia content for said at least five hundred recipients are different from at least some other of said individualized multimedia content.

2.   A system as recited in claim 1, wherein the means for creating and delivering individualized multimedia content over said network comprises a computer operatively coupled to said network for executing a programmed sequence of instructions which assemble said computer files from the multimedia content repository as selected

according to said individual information about one of said recipients, as extracted from

said recipient information repository, into a multimedia stream containing said computer

files delivered to said recipient and wherein each said email message comprises multiple

links, and the links for the email to at least some of said recipients are different from the

links for at least some others of said recipients.

3.   A system for creating and delivering a series of individualized multimedia

messages over a computer network using an email message sent simultaneously,

comprising:

       means for accessing information about an intended recipient with unique recipient

information for each of at least five hundred recipients;

       means for personalizing a multimedia message with computer files comprising at

least one of text and graphics files and at least one of audio and video files for the

intended recipient based upon information about a particular intended recipient; and

       means for delivering the multimedia message over the computer network to an

intended recipient including sending an email message simultaneously to each of at least

five hundred recipients, and wherein at least some of said individualized multimedia

content for said at least five hundred recipients are different from at least some other of

said individualized multimedia content.

4.   A system as recited in claim 3, wherein the means for accessing information about

an intended recipient comprises a data access routine within a programmed set of

instructions being executed within a computer, the data access routine for manipulating a database, local or remote, to extract information about a recipient.

5.   A system as recited in claim 4, further comprising an administration for monitoring and facilitating the creation of multimedia content within a multimedia campaign and includes routines of viewing/playing content, uploading content, searching content, and organizing multimedia content.

6.   A system as recited in claim 5, wherein the administration routines are for creating and maintaining database and directory structures.

7.   A system as recited in claim 5, further comprising file conversion routines for converting file formats within the system and for delivery to clients.

8.   A system as recited in claim 5, further comprising a clean up routine for selective clean up of a recipient database by removing errors and unwanted redundancies.

9.   A system as recited in claim 5, further comprising an archiving routine for saving files and associations within a particular campaign into an archive from which the campaign may be later restored and executed.

10.   A system as recited in claim 3, wherein the means for personalizing the multimedia message for the intended recipient comprises a multimedia engine routine

within a programmed set of instructions being executed within a computer, the

multimedia engine routine for assembling multimedia elements from a content database

into a multimedia message in response to information about the intended recipient and

wherein each said email message comprises multiple links, and the links for the email to

at least some of said recipients are different from the links for at least some others of said

recipients.

11.   A system as recited in claim 3, wherein the means for delivering individualized

multimedia message content to the intended recipients, comprises a delivery routine

within a programmed set of instructions being executed within a computer that is

operatively connected to a computer network, the delivery routine for formatting the

individualized multimedia message content for the intended recipient and for

subsequently delivering the individualized multimedia message over the network for the

intended recipient, wherein the message for the intended recipient may be delivered

directly to the recipient, or delivered indirectly through one or more systems which direct

the individualized multimedia message to the recipient and wherein each said email

message comprises multiple links, and the links for the email to at least some of said

recipients are different from the links for at least some others of said recipients.

12.   A system as recited in claim 11, wherein the individualized multimedia message

is delivered to each of the recipients as the email message which includes multimedia

content having text and graphics files and at least one of video and audio files in a format

selected from the group of multimedia formats consisting of Flash™, Real Audio™,

Quick Time^{TM}, Windows MP^{TM}, SWF, SWT, Java^{TM}, HTML/Embedded, animated GIF, and 3D^{TM}.

13.   A system as recited in claim 11, wherein the formatted individualized multimedia message is delivered to the recipient as the email message, and the message plays automatically when the recipient clicks on the message.

14.   A system as recited in claim 13, wherein the individualized multimedia message is delivered to the recipient, comprising markup language coding into which multimedia elements are operatively linked to play as the markup language is executed.

15.   A system as recited in claim 13, wherein the markup language coding is selected from the group of markup languages consisting of SGML, XML, and HTML.

16.   A system as recited in claim 11, wherein the individualized multimedia message is formatted for delivery to the recipient with the email message containing a unique URL link for each of said recipients that when activated retrieves the individualized multimedia message content.

17.   A system as recited in claim 16, wherein the activation of the unique URL link comprises execution of a first routine to collect individualized data and a second routine to display the individualized multimedia message content.

18.   A system as recited in claim 11, wherein the individualized multimedia message is formatted for downloading to the recipient as a monolithic file, such as Flash™, Real Audio™, Quick Time™, Windows MP™, SWF, SWT, Java™, HTML/Embedded, animated GIF, 3D™, MPEG, MP4, or JPEG file, that may be either viewed or played by the recipient utilizing conventional players or viewers to access the message.

19.   A system as recited in claim 11, wherein the individualized multimedia message may be converted to a format compatible with a graphic printer, such that individualized graphic output may be generated.

20.   A system for creating and distributing at least five hundred individualized multimedia messages over a computer network using an email sent simultaneously, comprising:

    (a)   a computer operatively connected to said network and executing a programmed sequence of instructions;

    (b)   a recipient information access routing within said programmed sequence of instructions for accessing data about a given intended recipient with unique recipient information for each of at least five hundred recipients;

    (c)   a content repository containing multimedia elements that may be combined to form individualized messages with computer files comprising at least one of text and graphics files, and further comprising at least one of audio and video files;

    (d)   a content management routine within said programmed sequence of instructions for retrieving selected multimedia content from the content repository,

wherein the process of selecting multimedia content is responsive to information content

regarding the given recipient accessed by the recipient information access routine;

(e) a multimedia engine routine within said programmed sequence of

instructions, for packaging the multimedia content as an individualized message for

delivery to the given recipient; and

(f) a delivery routine within said programmed sequence of instructions for

delivering the individualized message to each of the given recipients including sending an

email message simultaneously to each of at least five hundred recipients and wherein at

least some of said individualized multimedia content for said at least five hundred

recipients are different from at least some other of said individualized multimedia

content.

21. A system as recited in claim 20, wherein the content repository comprises a

structured database having a directory hierarchy.

22. A system as recited in claim 20, wherein the recipient information is accessed

within said programmed sequence of instructions using SQL, SAP and XML.

23. A system as recited in claim 20, wherein the delivery routine is configured to

deliver the multimedia message through a network for receipt on a media selected from

the group of media consisting of email, WAP enabled devices, wireless devices,

interactive TV, media files, and printed media.

24.   A system as recited in claim 20, wherein the delivery routine prepares the multimedia content for delivery in a specific delivery format.

25.   A system as recited in claim 24, wherein the delivery routine further comprises synchronization routines for synchronizing different multimedia streams, such as the synchronization of audio and video streams.

26.   A system as recited in claim 24, wherein the delivery format provides a mechanism for servicing data queries.

27.   A system as recited in claim 24, wherein the specific delivery format is selected from the group of delivery formats consisting of: Flash^{TM}, Real Audio^{TM}, Quick Time^{TM}, Windows MP^{TM}, SWF, SWT, Java^{TM}, HTML/Embedded, animated GIF, 3D^{TM}, and wireless.

28.   A system as recited in claim 20, wherein the delivery format is capable of being converted for output to a printer so that the individualized multimedia message may be printed out as individualized graphics and text on a printing device.

29.   A system as recited in claim 20, wherein the recipient information is extracted from a client database.

30.   A system as recited in claim 20, wherein the multimedia messaging system is directly interfaced to the client system with a data exchange protocol through which the recipient information may be extracted and wherein each said email message comprises multiple links, and the links for the email to at least some of said recipients are different from the links for at least some others of said recipients.

31.   A system as recited in claim 30, wherein the exchange protocol utilized is selected from a group of exchange protocols consisting of ODBC, and XML.

32.   A system as recited in claim 30, wherein a custom interface is created for interfacing the multimedia messaging system with the client database.

33.   A system as recited in claim 20, wherein the information about the intended recipient comprises a user name and an associated email address, so that the multimedia content may be customized with the user name and delivered to the email address of the recipient which is associated with the user name.

34.   A system as recited in claim 20, wherein the delivery routine is configured to deliver the multimedia content to the intended recipient as an email message through a client routine that is supplied with data comprising the recipient's name, email address and a unique URL pointing to the message content, wherein the client routine is then capable of deploying the email message with the URL.

35.   A system as recited in claim 34, wherein the delivery routine is further configured for delivery of the multimedia content to play spontaneously when highlighted within the recipient's email in-box.

36.   A system as recited in claim 35, wherein the email messages are deployed within an email campaign, said email campaign comprising a content database, and a list of recipients with associated personalization information.

37.   A system as recited in claim 36, further comprising an archiving routine for storing and retrieving email campaigns.

38.   A system as recited in claim 37, wherein the archiving routine is capable of storing all files and structures relating to a specific campaign, such that a completed campaign that has been archived may later be restored for further development or use.

39.   A system as recited in claim 20, wherein the client interface of the content management routine comprises a graphical user interface which displays information and allows for direct client input.

40.   A system as recited in claim 20, wherein the content management routine further comprises routines for directing content uploading, and the customization of the content database.

41.   A system as recited in claim 20, wherein the content management routine further comprises routines for providing file security for a campaign which restricts non-authorized parties from accessing a client campaign.

42.   A system as recited in claim 20, wherein the content management routine further comprises a comprehensive search engine for use on the content repository.

43.   A system as recited in claim 20, wherein the search engine further comprises a Thesaurus that is capable of looking up files in response to a set of keywords.

44.   A system as recited in claim 20, wherein the content management routine further comprises version control routines for managing file check-in and check-out by clients accessing the system.

45.   A system as recited in claim 20, wherein each of the elements of content being uploaded is represented on a screen and each element may be labeled by the client.

46.   A system as recited in claim 44, wherein labeling of a content element comprises adding a filename, description, and a keyword list.

47.   A system as recited in claim 20, further comprising a reporting routine for real-time reporting of content and usage statistics.

48.   A system as recited in claim 47, wherein the reporting routine is adapted for

further providing information on click-rate, click-tracking, sales, customer profiles, and

use patterns.

49.   A system as recited in claim 20, wherein the multimedia content comprises

graphics, animations, audio, and text which are utilized singly or in combinations thereof.

50.   A system as recited in claim 20, wherein the content management routine further

comprises a routine for synchronizing combinations of graphics, audio, and text for

presentation to the given recipient.

51.   A system as recited in claim 20, wherein the multimedia engine routine further

comprises a routine for modifying the individualized message content, such as the offer,

discount, coupon, or rebate, after the campaign has been deployed, wherein

individualized messages viewed or played after the modification will reflect the

modifications.

52.   A system as recited in claim 20, wherein the delivery routine further comprises a

routine for collecting delivery and personal information about an additional recipient

wherein the message may be re-individualized and delivered as word-of-mouth style

advertising to the additional recipient.

53.   A system as recited in claim 52, wherein the routine for collecting the delivery

and personal information further collects optional information from the original recipient,

such as recommendations, and an improved subject line.

54.   A system as recited in claim 20, wherein the packaged multimedia content is

delivered to the given recipient within an email message.

55.   A method of creating and distributing individualized multimedia messages over a

computer network using an email message sent simultaneously to at least five hundred

recipients, comprising:

        retrieving information about an intended message recipient from a recipient

database using a computer;

        personalizing a multimedia message for each said recipient based on the retrieved

information using a computer with unique recipient information for at least five hundred

recipients and the multimedia message including computer files comprising at least one

of text and graphics files, and further comprising at least one of audio and video files; and

        delivering, by using an email sent simultaneously to each of the at least five

hundred recipients, the multimedia message to each of said recipients over a computer

network and wherein at least some of said individualized multimedia content for said at

least five hundred recipients are different from at least some other of said individualized

multimedia content.

56.　　A method as recited in claim 55, wherein the information about the intended

recipient comprises a user name and an associated email address and wherein each said

email message comprises multiple links, and the links for the email to at least some of

said recipients are different from the links for at least some others of said recipients.

57.　　A method as recited in claim 55, wherein the individualized multimedia message

is assembled from multimedia segments which are selectably extracted from a content

database after one of the recipients opens the email.

58.　　A method as recited in claim 55, further comprising providing the client with the

ability to upload, search, and manage the multimedia content contained within the content

database.

59.　　A method as recited in claim 55, further comprising providing the ability to

archive email campaigns, which can later be restored for additional development or

deployment.

60.　　A method as recited in claim 55, wherein the delivery of the multimedia message

to said recipient is performed by sending emails to the recipients, wherein a unique URL

is embedded in each email which points to stored message content, wherein upon the

client opening the email the URL is activated and the individualized multimedia message

is played for the client.

61.   A method as recited in claim 60, wherein the email is delivered in a format capable of playing spontaneously when the email message is highlighted in the recipient's in-box or selected for opening.

62.   A method as recited in claim 55, wherein the delivery of the multimedia message to said recipient is performed by providing the client with the recipient's name, email address and a unique URL pointing to the message content, wherein the client then deploys the email message with the URL.

63.   A method as recited in claim 55, further comprising providing a database structure and directory structure for retrieving and processing multimedia files to be used in an email campaign.

64.   (Canceled)

65.   (Canceled)

66.   (Canceled)

67.   (Canceled)

68.   (Canceled)

69.   (Canceled)

70.   (Canceled)

71.   A system as recited in claim 1, wherein the unique individual information is
contained within the at least one of audio and video files, and the at least one of text and
graphics files and wherein the means for delivering the multimedia media message
delivers the multimedia message to the email after one of the recipients opens the email.

72.   A system as recited in claim 3, wherein there is unique individual information
contained within the at least one of audio and video files, and the at least one of text and
graphics files and wherein the means for delivering the multimedia media message
delivers the multimedia message to the email after one of the recipients opens the email.

73.   A system as recited in claim 20, wherein there is unique individual information
contained within the at least one of audio and video files, and the at least one of text and
graphics files and wherein the means for delivering the multimedia media message
delivers the multimedia message to the email after one of the recipients opens the email.

74.   A method as noted in claim 55, wherein the unique recipient information is
provided within the at least one of audio and video files and the at least one of text and
graphics files and wherein in the step of delivering the multimedia message, it is
delivered in response to opening the email.

75.   A system as noted in claim 34, wherein the unique URL is determined based on
a prior unique URL for the same recipient and wherein the means for delivering the

multimedia media message delivers the multimedia message to the email after one of the recipients opens the email.

76.   A method as noted in claim 60, wherein the unique URL is determined based on a prior unique URL for the same recipient and wherein in the step of delivering the multimedia message, it is delivered in response to opening the email.

77.   A system as noted in claim 34, wherein the unique URL is correlated with unique content in the message for the same recipient and wherein in the step of delivering the multimedia message, it is delivered in response to opening the email.

78.   A method as noted in claim 60, wherein the unique URL is correlated with unique content in the message for the same recipient and wherein in the step of delivering the multimedia message, it is delivered in response to opening the email.

EVIDENCE APPENDIX

None

BOARD OF PATENT APPEALS AND INTERFERENCES PRIOR DECISION

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,235	11/07/2000	Kevin Calloway	03-10074	1158

36212   7590   05/01/2009
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EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
05/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

————————

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

————————

Ex parte KEVIN CALLOWAY, JASON MCNAMARA, ERGON COPELAND,
ANTHONY FRANCO, ZVULUN HALFON, SCOTT JOHNSON,
RONALD KEWISH, and RICHARD WILSON

————————

Appeal 2009-0171
Application 09/708,235
Technology Center 3600

————————

Decided: [1] May 1, 2009

————————

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 DECISION ON APPEAL

2 STATEMENT OF THE CASE

3 Kevin Calloway, Jason McNamara, Ergon Copeland, Anthony Franco,

4 Zvulun Halfon, Scott Johnson, Ronald Kewish, and Richard Wilson (Appellants)

5 seek review under 35 U.S.C. § 134 of a non-final rejection of claims 1-63 and 71-

6 78, the only claims pending in the application on appeal.

7 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

8
9 We REVERSE.

10 The Appellants invented a way for automated creation and distribution of

11 individualized multimedia messages and content over a network. (Specification 2:

12 7-8).

13 An understanding of the invention can be derived from a reading of exemplary

14 claim 1, which is reproduced below [bracketed matter and some paragraphing

15 added].

16   1. A system for creating and distributing a series of individualized
17   multimedia messages over a computer network to a plurality of
18   recipients, comprising:

19   (a) a recipient information repository with unique recipient
20   information for at least a first and second recipient;

21   (b) a multimedia content repository with computer files

22   comprising at least one of text and graphics files,

23   and further comprising at least one of audio and video files; and

1   (c) means for creating and delivering individualized multimedia

2   content over said computer network to each of the plurality of

3   recipients,

4   wherein said multimedia content is assembled from selected

5   elements within the multimedia content repository

6   which are selected in response to individual information

7   about each of said recipients

8   whose individual information is extracted from the

9   recipient information repository.

10

11   This appeal arises from the Examiner's Non-Final Rejection, mailed August

12 16, 2006. The Appellants filed an Appeal Brief in support of the appeal on

13 October 29, 2007. An Examiner's Answer to the Appeal Brief was mailed on

14 February 15, 2008. A Reply Brief was filed on March 20, 2008.

15   PRIOR ART

16   The Examiner relies upon the following prior art:

Hibbeler   US 6,067,348   May 23, 2000

Smith   US 6,725,381 B1   Apr. 20, 2004

17   REJECTIONS

18   Claims 1-15, 18-33, 35-63, and 71-78 stand rejected under 35 U.S.C. § 103(a)

19 as unpatentable over Hibbeler and Official Notice.

20   Claims 16, 17, 34, 35, and 75-78 stand rejected under 35 U.S.C. § 103(a) as

21 unpatentable over Hibbeler, Smith, and Official Notice.[2]

---

[2] The Examiner did not explicitly include Official Notice in this rejection. These claims depend from the claims in the prior rejection that is based on Official Notice, and therefore this rejection must implicitly be similarly based on Official Notice at least as to the subject matter incorporated from the parent claims.

1   ISSUES

2   The issues pertinent to this appeal are

3   • Whether the Appellants have sustained their burden of showing that the

4   Examiner erred in rejecting claims 1-15, 18-33, 35-63, and 71-78 under

5   35 U.S.C. § 103(a) as unpatentable over Hibbeler and Official Notice.

6   • Whether the Appellants have sustained their burden of showing that the

7   Examiner erred in rejecting claims 16, 17, 34, 35, and 75-78 under 35 U.S.C.

8   § 103(a) as unpatentable over Hibbeler, Smith, and Official Notice.

9   These issues turn primarily on whether Hibbeler describes distributing

10   multimedia.

11   FACTS PERTINENT TO THE ISSUES

12   The following enumerated Findings of Fact (FF) are believed to be supported

13   by a preponderance of the evidence.

14   *Facts Related to Claim Construction*

15   01.   The disclosure contains no lexicographic definition of "multimedia."

16   02.   The ordinary and customary meaning of "multimedia" as a noun is the

17   combined use of media.[3]

18   *Hibbeler*

19   03.   Hibbeler is directed to personalization of an outbound audio message

20   (Hibbeler 1:6-8).

---

[3] *American Heritage Dictionary of the English Language* (4th ed. 2000).

4

1   04.   Hibbeler describes personalizing a message by storing a message

2   body, a plurality of greeting segments, assigning a unique index number

3   to each greeting segment, recalling the message body, recalling a

4   greeting segment using the unique index number, and combining the

5   greeting segment and the message body to form a personalized message

6   (Hibbeler 2:4-12).

7   05.   Hibbeler describes its distribution of its messages using a message

8   controller, a telecommunications card, and a communication link. In the

9   preferred embodiment, the communication link is a telephone line. The

10   telecommunications card is capable of handling communications over

11   multiple phone lines and hence able to rapidly transmit outbound

12   messages. In the preferred embodiment, the telecommunications card is

13   a telephony card capable of transmitting telephone messages over a

14   telephone line. In an alternative embodiment, the telecommunications

15   card is an Internet card capable of transmitting messages in a digital

16   format over the Internet (Hibbeler 6:15-40).

17 *Smith*

18 06.   Smith is directed to a mechanism by which a specific intended

19   recipient of a delivered document can be authenticated without prior

20   participation by the intended recipient (Smith 1:6-10).

21 *Facts Related To Differences Between The Claimed Subject Matter And The*

22 *Prior Art*

23 07.   Neither reference describes distributing multimedia.

24 *Facts Related To The Level Of Skill In The Art*

1   08.   Neither the Examiner nor the Appellants has addressed the level of

2   ordinary skill in the pertinent arts of systems analysis and programming,

3   multimedia data design and processing, and data communications. We

4   will therefore consider the cited prior art as representative of the level of

5   ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355

6   (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill

7   in the art does not give rise to reversible error 'where the prior art itself

8   reflects an appropriate level and a need for testimony is not shown'")

9   (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d

10   158, 163 (Fed. Cir. 1985).

11   PRINCIPLES OF LAW

12   *Claim Construction*

13   During examination of a patent application, pending claims are given

14   their broadest reasonable construction consistent with the specification. *In*

15   *re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*

16   *Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

17   Limitations appearing in the specification but not recited in the claim are not

18   read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.

19   Cir. 2003) (claims must be interpreted "in view of the specification" without

20   importing limitations from the specification into the claims unnecessarily)

21   Although a patent applicant is entitled to be his or her own lexicographer of

22   patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,

23   347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such

24   definitions in the specification with sufficient clarity to provide a person of

25   ordinary skill in the art with clear and precise notice of the meaning that is to be

1   construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although

2   an inventor is free to define the specific terms used to describe the invention, this

3   must be done with reasonable clarity, deliberateness, and precision; where an

4   inventor chooses to give terms uncommon meanings, the inventor must set out any

5   uncommon definition in some manner within the patent disclosure so as to give

6   one of ordinary skill in the art notice of the change).

7   *Obviousness*

8

9   A claimed invention is unpatentable if the differences between it and the

10 prior art are "such that the subject matter as a whole would have been obvious

11 at the time the invention was made to a person having ordinary skill in the art."

12 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30

13 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

14   In *Graham*, the Court held that that the obviousness analysis is bottomed on

15 several basic factual inquiries: "[(1)] the scope and content of the prior art are to be

16 determined; [(2)] differences between the prior art and the claims at issue are to be

17 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383

18 U.S. at 17. *See also KSR*, 127 S.Ct. at 1734. "The combination of familiar

19 elements according to known methods is likely to be obvious when it does no

20 more than yield predictable results." *Id*. at 1739.

21   "When a work is available in one field of endeavor, design incentives and

22 other market forces can prompt variations of it, either in the same field or a

23 different one. If a person of ordinary skill can implement a predictable variation,

24 § 103 likely bars its patentability." *Id*. at 1740.

25   "For the same reason, if a technique has been used to improve one device,

26 and a person of ordinary skill in the art would recognize that it would improve

7

1   similar devices in the same way, using the technique is obvious unless its actual

2   application is beyond his or her skill." *Id.*

3   "Under the correct analysis, any need or problem known in the field of

4   endeavor at the time of invention and addressed by the patent can provide a reason

5   for combining the elements in the manner claimed." *Id.* at 1742.

6   ANALYSIS

7   *Claims 1-15, 18-33, 35-63, and 71-78 rejected under 35 U.S.C. § 103(a) as*

8   *unpatentable over Hibbeler and Official Notice.*

9   The Examiner found that Hibbeler described the limitations of claim 1 except

10   for messages in graphic and video format. The Examiner took official notice that it

11   is old and well known to deliver messages in graphic and video format in order to

12   provide a visual representation of the data received. The Examiner concluded that

13   it would have been obvious to a person of ordinary skill in the art at the time of

14   Applicants' invention to have included the messages being graphic or video in

15   order to achieve the above mentioned advantage.

16   The Appellants contend that (1) in Hibbeler, the message is merely audio, and

17   thus is not "multimedia," as defined by the claim; (2) in Hibbeler, the message

18   body does not vary from recipient to recipient, an audio of the recipient's first name

19   is a "greeting segment" and is simply placed before the message body; (3) in

20   Hibbeler, there is no selection of message content based on (but different from

21   just) the individual recipient information; (4) in Hibbeler, the message is sent and

22   is not changed when sent, whether digital or not (Br. 11).

23   We disagree with the Appellants as to the last three arguments. In each case

24   the argument is not commensurate with the scope of the claim. Claim 1 does not

1   distinguish between the message body and greeting, but refers to content which

2   necessarily includes both greetings and body. Claim 1 does not further limit

3   the manner of individualizing content, and in particular does not exclude

4   individualization by the individual recipient information. Claim 1 does not use

5   the term "change" but instead requires that content is assembled from selected

6   elements within the content repository which are selected in response to individual

7   information about each of said recipients whose individual information is extracted

8   from the recipient information repository. Clearly Hibbeler's selection of a

9   greeting segment and adding that to a body is an assembly of content.

10   This is where we must depart from the Examiner. The Examiner found that

11   Hibbeler describes a means for creating and delivering multimedia content over the

12   network (Answer 3). This finding is in error. Hibbeler describes its distribution of

13   its messages using a message controller, a telecommunications card, and a

14   communication link. In the preferred embodiment, the communication link is

15   a telephone line. The telecommunications card is capable of handling

16   communications over multiple phone lines and hence able to rapidly transmit

17   outbound messages. In the preferred embodiment, the telecommunications card is

18   a telephony card capable of transmitting telephone messages over a telephone line

19   (FF 05).

20   Thus, the Appellants correctly contend that Hibbeler does not describe any

21   device distributing multimedia, i.e. combined media (FF 01 & 02). In fact,

22   Hibbeler only describes apparatus for distributing audio content. Neither reference

23   describes distributing multimedia (FF 08).

24   Although the Examiner took official notice that it is old and well known to

25   deliver messages in graphic and video format in order to provide a visual

1   representation of the data received, nothing in Hibbeler suggests, or would even

2   have the capacity to distribute such content. The Examiner has simply placed no

3   evidence that one of ordinary skill knew to distribute multimedia content from a

4   messaging service in the rejection. Accordingly the Examiner has failed to present

5   a prima facie case. Each of the remaining independent claims, included within this

6   rejection, contains a similar limitation regarding distribution of multimedia. Each

7   of the dependent claims necessarily includes such a limitation by virtue of

8   incorporating the limitations from the independent claims.

9   The Appellants have sustained their burden of showing that the Examiner erred

10   in rejecting claims 1-15, 18-33, 35-63, and 71-78 under 35 U.S.C. § 103(a) as

11   unpatentable over Hibbeler and Official Notice.

12   *Claims 16, 17, 34, 35, and 75-78 rejected under 35 U.S.C. § 103(a) as*

13   *unpatentable over Hibbeler, Smith, and Official Notice.*

14   Each of these claims depends from the independent claims in the prior

15   rejection. Smith provides no evidence to overcome the deficiencies in the

16   independent claim rejections. Accordingly, the Appellants have sustained their

17   burden of showing that the Examiner erred in rejecting claims 16, 17, 34, 35, and

18   75-78 under 35 U.S.C. § 103(a) as unpatentable over Hibbeler, Smith, and Official

19   Notice.

20   CONCLUSIONS OF LAW

21   The Appellants have sustained their burden of showing that the Examiner erred

22   in rejecting claims 1-63 and 71-78 under 35 U.S.C. § 103(a) as unpatentable over

23   the prior art.

1   DECISION

2   To summarize, our decision is as follows:

3   • The rejection of claims 1-15, 18-33, 35-63, and 71-78 under 35 U.S.C.

4   § 103(a) as unpatentable over Hibbeler and Official Notice is not sustained.

5   • The rejection of claims 16, 17, 34, 35, and 75-78 under 35 U.S.C. § 103(a)

6   as unpatentable over Hibbeler, Smith, and Official Notice is not sustained.

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8   <u>REVERSED</u>

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